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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/644,428

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Brian Greg Montano

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BAKER BOTTS, LLP

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EXAMINER

RODRIGUEZ, PAUL L

ART UNIT

PAPER NUMBER

2125

DATE MAILED: 04/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,428

Applicant(s)

MONTANO ET AL.

Examiner

Paul L Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/16/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-14 are presented for examination.

Claim Objections

2. Claims 1, 10 and 12 are objected to because of the following informalities:

Claim 1 line 5 recites “the compatibility”, the term “the” is similar to the term “said” in that it creates a positive recitation of the related term, would be better as “a compatibility” during the first use of the phrase to avoid any possible antecedent problems in the claims.

Claim 1 line 6 refers to “the other hardware components”, previously “hardware components”, “the hardware components”, “each hardware component” but never a reference to “other hardware components”, would be better as “...respect to other...” to avoid any possible confusion or possible antecedent problems in the claims.

Claim 1 line 10 refers to “the successful evaluation”, would be better as a successful evaluation because the term not previously used.

Claim 10 line 9 recites “the compatibility”, would be better as “a compatibility” during the first use of the phrase to avoid any possible antecedent problems in the claims.

Claim 10 line 10 refers to “the other hardware components”, would be better as “...respect to other...” to avoid any possible confusion or possible antecedent problems in the claims.

Claim 10 line 14 refers to “the successful evaluation”, would be better as a successful evaluation because the term not previously used.

Claim 12 line 4 recites “the compatibility”, would be better as “a compatibility” during the first use of the phrase to avoid any possible antecedent problems in the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 1 recites the limitation "the base architecture" in line 8. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 2 recites the limitation "the selected hardware component" in line 4. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 3 recites the limitation "the customer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 9 recites the limitation "the assembled hardware components" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 10 recites the limitation "the base architecture" in line 12. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 11 recites the limitation "the customer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 13 recites the limitation "the customer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 13 recites the limitation "the set of hardware components" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 14 recites the limitation "the base architecture" in line 3. There is insufficient antecedent basis for this limitation in the claim.

14. The examiner has provided a number of examples of the claim deficiencies in the above, however, the list of deficiencies may not be all inclusive. Applicant should refer to these as examples of deficiencies and should make all the necessary corrections to eliminate the claim objections.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

16. Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Connor (U.S. Pat 5,894,571).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The claimed invention reads on O'Connor as follows:

O'Connor discloses (claim 1, 10, 12, 14) a method for installing hardware components in a computer system (col. 2 lines 24-26, 44-46, 55-59, col. 3 lines 3-6, reference number 114, regarding claim 10 it is considered inherent that the computer system assembled would include a processor, memory and storage device), comprising compiling or receiving a list of the hardware components (col. 2 lines 41-44, 53-54, col. 2 line 63 – col. 3 line 3, col. 4 lines 16-18), assigning an installation location for each hardware component of the computer system (col. 2 lines 25-26, Examiner considers a selected configuration would inherently include the install locations, col. 3 lines 1-2, col. 5 lines 4-5), evaluating the compatibility of each hardware component of the computer system with respect to the other hardware components of the computer system, evaluating the compatibility of each hardware component of the computer system with respect to the base architecture of the computer system (col. 4 lines 38-55, col. 8 lines 20-26), identifying or displaying in graphical form the assigned installation locations of the hardware components of

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the computer system following the successful evaluation of the compatibility of the hardware components with respect to (a) the other hardware components of the computer system and (b) the base architecture of the computer system (col. 2 lines 41-44, 53-54, col. 2 line 63 – col. 3 line 3, col. 4 lines 46-50, col. 4 line 56 – col. 5 line 7, a list is considered a graphical form), and installing the hardware components according to the assigned installation locations (col. 5 lines 5-7), (claim 2) wherein the step of evaluating the compatibility of each hardware component of the computer system with respect to the base architecture of the computer system further comprises the step of evaluating the compatibility of the installation location with respect to the selected hardware component (col. 4 lines 46-50), (claim 3, 11, 13) wherein the list of hardware components includes custom hardware components selected for installation by the customer of the computer system (col. 2 lines 39-44, 50-55, col. 4 lines 14-18, 38-45), (claim 4) wherein the step of compiling a list of hardware components comprises the step of generating an architecture resource file that includes an identification of the hardware components and base architecture of the computer system (col. 3 lines 12-21, col. 5 lines 66-67), (claim 5) further comprising the step of displaying instructions identifying incompatible hardware components (col. 4 lines 38-55, col. 5 lines 7-10, col. 8 lines 20-26), (claim 6) wherein the step of compiling a list of hardware components comprises the step of receiving a customer order and generating a list of hardware components from the customer order (col. 2 lines 39-44, 50-55, col. 4 lines 38-60), (claims 7-9) further comprising the step of assigning an identification number to the computer system, wherein the identification number is a serial number, wherein the identification number identifies the assembled hardware components (col. 3 lines 12-21). Examiner would like to point out that

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any reference to specific figures, columns and lines should not be considered limiting in any way, the entire reference is considered to provide disclosure relating to the claimed invention.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang et al (U.S. Pat 6,446,243).

Huang et al teaches (claim 1) a method for installing hardware components in a computer system (reference number 20, col. 4 lines 11-55, a circuit or system considered a computer system), comprising compiling a list of the hardware components (reference number 10-14, col. 4 lines 11-33, col. 5 lines 5-26), assigning an installation location for each hardware component of the computer system (col. 4 lines 42-46, col. 5 lines 15-26), evaluating the compatibility of

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each hardware component of the computer system with respect to the other hardware components of the computer system (abstract, figure 5, col. 4 lines 30-64), evaluating the compatibility of each hardware component of the computer system with respect to the base architecture of the computer system (abstract, figure 5, col. 4 lines 30-64), identifying in graphical form the assigned installation locations of the hardware components of the computer system following the successful evaluation of the compatibility of the hardware components with respect to (a) the other hardware components of the computer system and (b) the base architecture of the computer system (col. 4 lines 50-55, col. 5 lines 27-35) and installing the hardware components according to the assigned installation locations (reference number 20), (claim 10) a computer system, comprising a processor; a memory; a storage device; the computer system having been manufactured in accordance with a manufacturing process (abstract, col. 4 lines 11-55), (claim 12) a method for assigning installation locations for hardware components in a computer system (reference number 10-16, col. 4 lines 42-46, col. 5 lines 15-26) comprising the steps of receiving a list of hardware components (reference number 10), evaluating the compatibility of each hardware component (abstract, figure 5, col. 4 lines 30-64), selecting an installation location for each hardware component in the computer system (reference numbers 16-18), and displaying a graphical representation of the installation locations of the hardware components of the computer system (col. 4 lines 50-55, col. 5 lines 27-35). Regarding dependent claims (claim 2, 14) wherein the step of evaluating the compatibility of each hardware component of the computer system with respect to the base architecture of the computer system further comprises the step of evaluating the compatibility of the installation location with respect to the selected hardware component (reference number 18), (claim 3) wherein the list of

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hardware components includes custom hardware components selected for installation by the customer of the computer system (obvious is a system were being designed it would be for an intended purpose of for a customer), (claim 4) wherein the step of compiling a list of hardware components comprises the step of generating an architecture resource file that includes an identification of the hardware components and base architecture of the computer system (reference number 510 HDL file), (claim 5) further comprising the step of displaying instructions identifying incompatible hardware components (col. 6 lines 37-43), (claim 6, 11, 13) wherein the step of compiling a list of hardware components comprises the step of receiving a customer order and generating a list of hardware components from the customer order (obvious), (claim 7-9) further comprising the step of assigning an identification number to the computer system (col. 5 lines 8-38). Examiner would like to point out that any reference to specific figures, columns and lines should not be considered limiting in any way, the entire reference is considered to provide disclosure relating to the claimed invention.

Huang et al fails to use specific language and terms recited by the instant claims, the Examiner considers the Huang et al to encompass a teaching broad enough to read on the claimed invention.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the method and system for design, verification and assembly of a circuit or a system of Huang et al for a method and system for installing hardware components in a computer system, evaluating compatibility and installing or producing the components as claimed above because Huang et al teaches a computer assisted method and apparatus for design verification and assembly of circuits and systems with advantages relating to circuit design and

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verification by identifying potential mistakes during integration and testing (col. 3 lines 16-44).

While the circuit or system is not identified as a personal computer, an integrated circuit can be considered a computer system.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kroening et al (U.S. Pat 6,735,757) – teaches an apparatus and method for verifying compatibility in a build to order computer system.

LaLonde et al (U.S. Pat 6,240,328) – teaches the generation of Electronic Work Instructions.

Henson (U.S. Pat 6,167,383) – teaches online ordering of a computer system, which uses a configurator to verify the configuration.

Kroening et al (U.S. Pat 6,080,807) - teaches an apparatus and method for verifying compatibility in a build to order computer system.

Fisher et al (U.S. Pat 6,038,399) – teaches a computer manufacturing environment that uses configuration rules to avoid incompatibilities in hardware and software.

Morimoto et al (U.S. Pat 5,961,557) – teaches a design system that verifies the design for a computer system.

Rotem et al (U.S. Pat 5,465,216) – teaches design verification for logic circuits such as computer systems.

Cicciarelli et al (U.S. Pat 4,870,591) – teaches ensuring device compatibility.

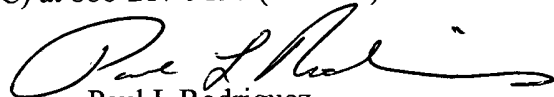
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20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul L Rodriguez whose telephone number is (571) 272-3753.

The examiner can normally be reached on 6:00 - 4:30 T-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo P Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul L Rodriguez
Primary Examiner
Art Unit 2125

PLR
4/6/05